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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,058	09/19/2003	Stefan J. Rublowsky	PRKR-4500	7284

7590 11/15/2005

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,058

Applicant(s)

RUBLOWSKY ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,6-10,12,14 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,6-10,12,14 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2,4,6,7,8,9,12,14,18,19,20,21,22,23,24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by DuCorday (4800110).

DuCorday also teaches an elongated strip (spine section 16 of 10) containing a substrate with a heat activated adhesive 26 thereon that contains grooves 34,36 (i.e. deformities). The grooves appear, from the figures, to be more than 20% the thickness of the adhesive. This rejection is being made to specifically address the limitation that the grooves run the length of the strip. The grooves run parallel to the longitudinal axis of intermediate spine section 16. The applicant, due to the use of the open claim language to 'comprising', is not excluding any other section of the strip. It can be seen from applicants' figures 4 and 6a-6C that the prior arts adhesive runs the same direction along the binding. With respect to the product by process claims 2, 4, 12, 14, 18, 20 and 21, it must be emphasized that it is the patentability of the product that is in issue not the patentability of the process steps employed to prepare the product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. The prior art contains the same structure as recited for the product.

3. Claims 2, 4, 6, 7, 8, 10, 12, 14, 18-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Werner (5678861).

Werner discloses an elongated strip 17 comprising a substrate 21 with heat activated adhesive 25 thereon. The adhesive also runs the length of the strip. Refer to figure 10-12. The adhesive has what can be considered grooves 33 (i.e. deformities) that run at least through 20% of the thickness thereof (it actually runs all the way through). Section 33 can also be considered punctures per instant claims 10 and 26 since it extends entirely through the adhesive layer. Werner specifically teaches these deformities in order to reduce curl (see column 6, lines 35-38).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over DuCorday in view of Pogrzeba et al (4247273) or Liland et al (4612230).

The primary references teach the invention substantially as recited except for the deformities to be punctures. Refer to the 35 USC 102 rejections above. The applicant discusses the punctures, on page 11 of the specification, as being formed using an awl, which would form an indent in the adhesive.

Pogrzeba et al teaches that either grooves or indents (punctures as described above) can be formed in a layer in order to prevent a "winged effect" (i.e. curling). This deforming leads to a greater stability in shape of the layer. This is the same reason the applicant is deforming the adhesive layer (i.e. to reduce curl). Refer to figures 3a and 3b

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along with column 2, lines 41-52. Liland et al discloses punctures 15 formed in the substrate portion of an adhesive tape in order to reduce curl. Refer to figure s 1-3 along with column 2, lines 14-18.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the DuCorday to form the deformities of a puncture shape, as taught by the secondary references, in order to provide greater stability to the layer by preventing curl of the layer motivated by the fact the secondary references teach the deformities reduce curl.

Response to Arguments

6. Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive. The applicant argues that DuCorday does not teach a conventional binder strip with the adhesive running the length of the strip. However, section 16 or the section with the adhesive can be considered the strip portion. As indicated above the applicant is not excluding any other sections of the binder from the claims due to the open claim language drawn to "comprising".

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

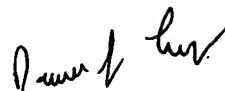
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Donald Loney", written in a cursive style.

Donald Loney
Primary Examiner
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DJL:D.Loney
11/11/05